

Appl No.: 10/817,283

Atty. Dkt.  
PC1664**REMARKS/ARGUMENTS**

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 4, 7, 10, 13, 16, added new claims 27-29 and canceled claims 3, 6, 9, 12, 15, 18, 19-25. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks. Applicant gratefully appreciates the examiner's indication that dependent claims 3, 6, 9, 12, 15, 18 contain allowable subject matter if amended into their independent claims.

Independent claim 1 has been amended to include the novel allowable subject matter of former dependent claim 3. Independent claim 4 has been amended to include the novel allowable subject matter of former dependent claim 6. Independent claim 7 has been amended to include the novel allowable subject matter of former dependent claim 9. Independent claim 10 has been amended to include the novel allowable subject matter of former dependent claim 12. Independent claim 13 has been amended to include the novel allowable subject matter of former dependent claim 15. Independent claim 16 has been amended to include novel allowable subject matter of former dependent claim 18.

As to the restriction requirement previously raised by the Examiner, applicant notes that this restriction requirement was not repeated by the Examiner in the subject office action. However, PTO Form 326 lists nonselected claims 19-25 as being withdrawn from consideration. Applicant again argues against the restriction requirement for the reasons presented in the election response July 25, 2006. Applicant has temporarily canceled the nonselected claims, and reserves the right to file a divisional application on such claims if the examiner maintains the restriction requirement.

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If the restriction requirement has been removed, applicant respectfully requests the applicant be allowed to reinstate claims 19-25 into the subject application.

Claims 4, 7, 13 and 26 were objected to for several informalities. Applicant has amended these claims to overcome the objections raised. Thus, removal of these objections are respectfully requested.

Claims 16-18 and 26 were rejected under sec. 112, first paragraph as failing to comply with the written description. Applicant has amended the term "any" to read "an additional" so that the claims read on "without an additional reject load" which the examiner admits in this rejection is covered by the specification. Thus, removal of this rejection is respectfully requested.

Claims 1-2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17 and 26 were rejected under sec. 103 as being unpatentable by Kroeger '249. The rejection against claims 1-2, 4, 5, 7, 8, 10, 11, 13, 14, 16, and 17 are now moot in view of the amendments to the independent claims. As previously noted, Independent claim 1 has been amended to include the novel allowable subject matter of former dependent claim 3. Independent claim 4 has been amended to include the novel allowable subject matter of former dependent claim 6. Independent claim 7 has been amended to include the novel allowable subject matter of former dependent claim 9. Independent claim 10 has been amended to include the novel allowable subject matter of former dependent claim 12. Independent claim 13 has been amended to include the novel allowable subject matter of former dependent claim 15. Independent claim 16 has been amended to include novel allowable subject matter of former dependent claim 18.

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As to independent claim 26, applicant has amended this claim to clarify that the transmitters are FM transmitters and operate at power levels of approximately 7,000 watts to approximately 35,000 watts, which is significantly different from those in Kroeger. Figure 2 of Kroeger is limited to an AM radio broadcasting method only, using one transmitter and would generally be limited to low power levels of less than 7,000 watts. FM radio stations broadcast at higher power levels. The invention has claimed in claim 26 uses two FM transmitters (one FM analog transmitter, and a second digital/analog transmitter). By injecting the analog component into the digital/analog transmitter, the invention is able to vary and reduce the combining coupling coefficient from 10dB down to 3 dB. This allows the system to operate more efficiently, dramatically reducing power lost into a reject load, reducing heat loading, and improving efficiency.

New independent claim 28 is a system claim claiming similar features to that of independent method claim 26, and new dependent claims 27 and 29 recite the combiner to be a 3 dB Hybrid combiner.

Applicant disagrees with the Examiner's statement that in regard to dependent claims 2, 8, 14, 17, 5, 11, it would have been well known to "have a 3 dB coupler instead of a 10 dB coupler...."

It is clearly improper for the examiner to arbitrarily ignore any of the novel features of the claims. Under the rules, if the applicant requests the examiner cite the reference(s) showing each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that at least these features are obvious under sec. 103. If actual references are not cited and supplied to the applicant to show these unsubstantiated opinions and assertions mentioned in their

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rejection, the the applicant respectfully requests removal the 103 rejection for at least these reasons alone.

Arguably, it might be "obvious to try" to test whether the use of a 3 dB Hybrid combiner. However, Examiner is well aware that "obvious to try" is not the standard for determining inventiveness. See also *In re Kaplan*, 789 F. 2d at 1580, 229 U.S.P.Q. at 683, where the court held:

"In effect, what the Board did was to use a disclosure of appellants' own joint invention which had been incorporated in the Kaplan sole disclosure to show that their invention was but an obvious variation of Kaplan's claimed invention. That amounts to using an applicant's invention disclosure, which is not a 1-year time bar, as prior art against him. That is impermissible."

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying Kroeger or the other references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, and 26-29 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be


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established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1, 2, 4, 5, 7, 8, 10, 11, 13, 14, 16, 17, and 26-29 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;

  
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Brian S. Steinberger  
Registration No. 36,423  
101 Brevard Avenue  
Cocoa, Florida 32922  
Telephone: (321) 633-5080Date 1/8/07